

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claim 9 is added relating to the use of the claimed pharmaceutical preparations to treat antibacterial infections. See the entire disclosure, especially the very first sentence for support. Applicants do not believe claim 9 introduces any new matter.

Claims 1-8 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have canceled without prejudice the wording “with retarding active ingredient release” from each of the claims.

Claims 1, 2, 4, 5, 7 and 8 were rejected under 35 USC § 103(a) as being obvious over Franz et al. (“Franz”), US 5,797,873. In response, Applicants submit that the Examiner has not made out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

According to *Manual of Patent Examining Procedure* (“MPEP”) § 2143:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

[Emphasis added.]

The instant claims require the pharmaceutical preparation to comprise “a mixture of *powdery* teicoplanin and at least one *powdery*, water soluble salt form of at least one of [a list of second antibiotics.]” The Examiner’s rejection does not deal with this powdery limitation at all. Therefore, as a matter of law, the Examiner cannot have made out a *prima facie* case of obviousness.

Also, as should be apparent in the immediately preceding quote, the instant claims require that the at least one of gentamicin, clindamycin and vancomycin must be in the claimed pharmaceutical preparation “in a *water soluble salt* form.” The Examiner has ignored this limitation as well, as there is no mention in Franz that Applicants can find of the gentamicin, clindamycin or vancomycin being present in a water soluble salt form.

Further, the Examiner says Franz teaches various ingredients of the present claims in the paragraph bridging columns 3 and 4. Applicants concede that teicoplanan,

gentamicin, clindamycin and vancomycin are mentioned there. However, there is no teaching or suggestion in Franz to use these antibiotics in combination, let alone to select them in the fashion required by the instant claims, i.e., teicoplanan as the first antibiotic, and at least one of gentamicin, clindamycin and vancomycin as the second antibiotic.

Respectfully, this rejection is improper in not dealing with all claimed limitations, and in inadequate evidence of motivation to make the claimed pharmaceutical preparations comprising mixtures of powdery teicoplanan and powdery water soluble salts of at least one of the recited list of second antibiotics. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Claim 3 was rejected under 35 USC § 103(a) as being obvious over Franz in view of Pietsch, US 4,588,583.

Claim 6 was rejected under 35 USC § 103(a) as being obvious over Franz in view of Pratt et al. ("Pratt"), US 4,283,799.

In response to the rejections of claims 3 and 6, Applicants point out that both rejections were dependent upon Franz rendering obvious the subject matter of claim 1. Since Applicants have explained above why Franz does not, in fact, render obvious the subject matter of claim 1, Applicants submit that the rejections of claims 3 and 6 are likewise improper. Thus, the combination of Franz and Pietsch and the combination of Franz and Pratt does not bridge the gaps noted above between Franz's disclosure and

main claim 1. Therefore, the combinations of Franz and Pietsch and Franz and Pratt also do not make out *prima facie* cases of obviousness.

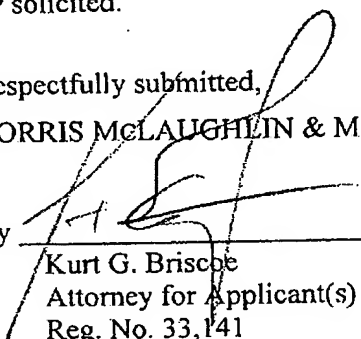
Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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By



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